

al.(hereinafter Silverman et al.), U.S. Patent No. 5,257,253 to Otsubo et al. (hereinafter Otsubo et al. '253), or U.S. Patent No. 5,177,728 to Otsubo et al. (hereinafter Otsubo et al. '728).

Applicants respectfully traverse the rejection under 35 U.S.C. § 112 ¶1, on the grounds that claims 7-14 recite neither a "processing means" nor "stereophony" sound. Independent claim 7 does recite a "signal processor," but Applicants respectfully submit that this element is both described and enabled under 35 U.S.C. § 112 ¶1 by at least FIG. 6, and the accompanying description in the specification. Applicants also note that claims 12-14 are method claims, and hence do not appear to fall under the § 112 ¶1 rejection as stated in the Office Action because they recite only steps.

As an initial matter, the Examiner has rejected claims 7-14 under 35 U.S.C. 102(e) as being anticipated by Ostrover et al. Additionally, the Examiner has rejected claims 7-14 under 35 U.S.C. 103(a) as being unpatentable over Ostrover et al. Applicants respectfully direct the Examiner to applicants' claim of priority under 35 U.S.C. §119 to Korean Patent Application No. 18841/1993, filed September 17, 1993. See Applicants' transmittal letter, filed December 11, 1998. Applicants respectfully submit that Ostrover et al. was filed on October 29, 1993. Therefore, Applicants submit that Ostrover et al. cannot be considered prior art to reject the claims of Applicants' invention. Accordingly, applicants respectfully request the Examiner to withdraw all rejections of the claims based on Ostrover et al.

Additionally, Applicants submit that the allegation of anticipation by Ostrover et al. is procedurally deficient. The Examiner has set forth no more than the name of the reference in support of an allegation of unpatentability. This is not sufficient to establish

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT
& DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, D. C. 20005
202-408-4000

a *prima facie* case of anticipation, as the Examiner must, having the initial burden. To make such a *prima facie* case, the Examiner must set forth some evidence (e.g., reference numerals, Figure numbers, column and row citations, etc.) to support his allegation. No such evidence has been advanced by the Examiner, and Applicants respectfully submit that no *prima facie* case exists to rebut. The above explanation notwithstanding, Applicants also submit that Ostrover et al. does not anticipate the subject matter of claims 7-14, for the reasons below.

Independent claim 7 requires a device for processing an audio signal including, *inter alia*, a selector for selecting one of the separated audio signals in response to an input applied from a key matrix. Ostrover et al. fails to disclose the claimed device. Neither the system shown in Fig. 2 or the accompanying description teaches the claimed key matrix or input applied from such a matrix. Nor does Ostrover et al. teach a selector for selecting one of the separated audio signals in response to such input from a key matrix. Furthermore, Ostrover et al. fails to disclose either a "digital signal including: a video signal, a plurality of audio signals composed of at least one sector of audio information, and indicating information located in front of each said audio signal and video signal" or a signal processor for receiving said digital signals as recited in the claimed invention. Thus, Ostrover et al. does not teach all elements of claim 7, and its rejection should be withdrawn. Claims 8-10 are allowable by virtue of their dependency from claim 7, as well as for their additional novel subject matter.

Similarly, independent claim 12 requires a device for processing an audio signal including, *inter alia*, selecting one of the separated audio signals in response to an input

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT
& DUNNER, L.L.P.
1300 I STREET, N.W.
WASHINGTON, D. C. 20005
202-408-4000

applied from a key matrix. Because Ostrover et al. fails to teach the claimed selector of claim 7, it also fails to teach the claimed selecting function of claim 12. In addition, as with claim 7, Ostrover fails to disclose the demodulation of the digital signal or receiving of the digital signal including indicating information. Thus, Ostrover et al. does not teach all elements of claim 12, and its rejection should be withdrawn. Claims 13 and 14 are allowable by virtue of their dependency from claim 12, as well as for their additional novel subject matter.

To establish a *prima facie* case of obviousness, two basic criteria must be met. First, the prior art references when combined must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. See M.P.E.P. § 2143.

Applicants respectfully traverse the rejection under 35 U.S.C. § 103(a) of claims 7-14, because the references as combined fail to teach or suggest all the claim elements. The requirements of independent claims 7 and 12 are discussed above. Claims 7 and 12 also require, *inter alia*, a digital signal including a plurality of audio signals, and separating the plurality of audio signals based on extracted indicating information. Contrary to the Examiner's assertion, neither Applicants' FIGs. 1 and 2, nor pages 1-4 of Applicants' specification, teaches or suggests the claimed plurality of audio signals or separating the same. See Applicants' specification, page 4, lines 15-19. Thus, Applicants' "admitted prior art" fails to teach or suggest all elements attributed to it.

Further, as explained above, Ostrover et al. fails to teach or suggest a selector

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT
& DUNNER, L. L. P.
1300 I STREET, N. W.
WASHINGTON, D. C. 20005
202-408-4000

for selecting one of the separated audio signals in response to an input from a key matrix, the digital signal including indicating information, or signal processor for receiving such a digital signal. Therefore, Applicants submit Ostrover et al. fails to cure the deficiencies of the "admitted prior art".

Applicants respectfully submit that none of Kim, Silverman et al., Otsubo et al. '253, or Otsubo et al. '728 teaches or suggests this element of claims 7 and 12, either.

Kim discloses a recording and selective reproduction of a voice signal received from a tuner and external voice signal. However, Kim fails to disclose or suggest the claimed key matrix or input applied from such a matrix as recited in the claimed invention. Additionally, Kim fails to teach or suggest a selector for selecting one of the separated audio signals in response to such input from a key matrix. Furthermore, Kim fails to disclose either a "digital signal including: a video signal, a plurality of audio signals composed of at least one sector of audio information, and indicating information located in front of each said audio signal and video signal" or a signal processor for receiving said digital signals as recited in the claimed invention. Thus, Kim fails to cure the deficiencies of the "admitted prior art."

Silverman et al. discloses a video system in which multiple languages can be encoded within a bandwidth of a standard video signal. As with Ostrover et al. and Kim, Silverman et al. fails to disclose or suggest the claimed key matrix or input applied from such a matrix as recited in the claimed invention. Additionally, Silverman et al. fails to teach or suggest a selector for selecting one of the separated audio signals in response to such input from a key matrix. Furthermore, Silverman et al. fails to disclose either a "digital signal including: a video signal, a plurality of audio signals composed of at least

one sector of audio information, and indicating information located in front of each said audio signal and video signal" or a signal processor for receiving said digital signals as recited in the claimed invention. Thus, Silverman et al. fails to cure the deficiencies of the "admitted prior art."

As with Ostrover et al., Kim, and Silverman et al., both Otsubo et al. '253, and Otsubo et al. '728 fail to disclose or suggest the claimed key matrix or input applied from such a matrix as recited in the claimed invention. Additionally, both Otsubo et al. '253, and Otsubo et al. '728 fail to teach or suggest a selector for selecting one of the separated audio signals in response to such input from a key matrix. Thus, both Otsubo et al. '253, and Otsubo et al. '728 fail to cure the deficiencies of the "admitted prior art."

Should the Examiner maintain this rejection, he is respectfully requested to provide specific Figures, element numbers, and/or column/row numbers where this element is allegedly taught or suggested. For these reasons, the combination of references fails to teach or suggest all elements of claims 7 and 12, and a *prima facie* case of obviousness has not been established for these two claims. Claims 8-10, 13, and 14 are allowable by virtue of their respective dependency from claims 7 and 12, as well as for their additional novel subject matter.

Moreover, a *prima facie* case of obviousness has not been established, because there would have been no motivation to combine the references as suggested. The stated justification, "to provide a more pleasurable presentation to an end user," is conclusory. No specific teaching in any of the references of a "more pleasurable presentation" has been cited, notwithstanding the invitation to "see the figures and

abstracts." Any such teaching must be shown by the Examiner, and not uncovered by the Applicants. Even if there were such a teaching of a "more pleasurable presentation" in the references, the Examiner has not provided a reasoned explanation as to why one of ordinary skill in the art, presented with this teaching, would have combined the references with the apparatus shown in Applicants' FIG. 2. For these additional reasons, a *prima facie* case of obviousness has not been established for claims 7-14 and the rejection should be withdrawn.

Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of pending claims 7-14.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: Walter F. Sutcliffe Reg. No. 24,914
for Andrew Chanho Sonu
Reg. No. 33,457

Dated: June 17, 1999

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT
& DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, D. C. 20005
202-408-4000